

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Docket No.: P26995

C. L. BATES, *et al.*

Confirmation No.: 7213

Serial No.: 09/827,233

Group Art Unit: No. 2143

Filed: April 5, 2001

Examiner: D. E. England

For: **METHOD AND COMPUTER PROGRAM PRODUCT FOR PROVIDING
EMAIL THAT GUIDES A RECIPIENT THROUGH A SET OF ASSOCIATED
WEB PAGES**

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This appeal is from the Examiner's final rejection of claims 1-20 as set forth in the Final Office Action of February 27, 2007. A Notice of Appeal and Request for Pre-Appeal Brief Review, in response to the February 27, 2007 Final Office Action, was filed on May 16, 2007. A Panel Decision issued on July 18, 2007. The instant Appeal Brief is being timely submitted within one month of the Panel Decision, i.e., by August 20, 2007 (August 18, 2007 being a Saturday).

Payment in the amount of \$ 500.00 is being concurrently submitted as payment of the requisite fee under 37 C.F.R. 41.20(b)(2). No additional fee is believed to be required for filing the instant Appeal Brief. However, if for any reason a necessary fee is required for consideration of the instant paper, authorization is hereby given to charge the fee for the Appeal Brief and any necessary extension of time fees to Deposit Account No. 09-0457.

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(I) REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation by an assignment recorded in the U.S. Patent and Trademark Office on April 5, 2001, at Reel 011713 and Frame 0270.

(II) RELATED APPEALS AND INTERFERENCES

No related appeals and/or interferences are pending.

(III) STATUS OF THE CLAIMS

Claims 1-20 are pending. Claims 1-20 stand finally rejected. Thus, finally rejected claims 1-20 are at issue in the instant appeal and form the subject matter of the instant Appeal Brief. The claims in issue are attached in the "Claims Appendix".

(IV) STATUS OF THE AMENDMENTS

A Response under 37 C.F.R. § 1.116 was filed April 4, 2007, requesting reconsideration of the finally rejected claims. The Examiner responded with an Advisory Action mailed May 3, 2007, indicating that the Response was considered, but did not place the application in condition for allowance. The Advisory Action did, however, withdraw the Section 112, 2nd paragraph, rejection of claims 1-3, 8-11 and 16 as regards "a preferred viewing order". Appellant submits that no amendments after final have been filed; however, all amendments to the claims have been entered.

(V) SUMMARY OF THE CLAIMED SUBJECT MATTER**The Claimed Subject Matter****INDEPENDENT CLAIM 1**

With reference to page 6, line 6 to page 11, line 13 of the instant application and to Figs 1-4, and by way of non-limiting example, the invention provides for a method for providing email that enables a recipient (110) of the email to navigate readily through a set of web pages associated with the email (see page 6, lines 7-9 of the specification), comprising the acts of composing an email (see page 6, lines 11-12 of the specification) to be sent from an originator (100) to a recipient (110). The method also provides that in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient (see page 6, lines 6-9 and 11-16 of the specification). The method also includes associating the navigation with the email (see page 6, line 16 to page 7, line 2 of the specification) and sending the email and the navigation to the recipient (see page 7, lines 2-3 of the specification).

INDEPENDENT CLAIM 2

With reference to page 6, line 6 to page 11, line 13 of the instant application and to Figs 1-4, and by way of non-limiting example, the invention provides for a method for guiding a recipient (110) of an email readily through a set of web pages associated with the email, comprising the acts of receiving an email (see page 7, lines 2-3 of the specification). The method also includes receiving a web page navigation associated with the email (see page 7, lines 2-5 of

the specification). Additionally, the method includes passing the web page navigation to a web browser (see page 7, lines 2-5 of the specification) and displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed (see page 7, lines 5-6 of the specification). The preferred viewing order is included in the navigation (see page 6, lines 14-16 of the specification).

INDEPENDENT CLAIM 3

With reference to page 6, line 6 to page 11, line 13 of the instant application and to Figs 1-4, and by way of non-limiting example, the invention provides for a method for providing email that guides a recipient (110) readily through a set of associated web pages, comprising the acts of composing an email (see page 6, lines 11-12 of the specification) to be sent from an originator (100) to a recipient (110). The method also provides that in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order (see page 6, lines 6-9 and 11-16 of the specification). The method also includes sending the email and the web page navigation to the recipient (see page 7, lines 2-3 of the specification), passing the web page navigation to a web browser used by the recipient (see page 7, lines 2-5 of the specification), and displaying by the web browser an indication of the preferred viewing order (see page 7, lines 5-6 of the specification).

INDEPENDENT CLAIM 8

With reference to page 6, line 6 to page 11, line 13 of the instant application and to Figs 1-4, and by way of non-limiting example, the invention provides for a method for providing

email that guides a recipient (110) readily through a set of associated web pages, comprising the acts of composing an email (see page 6, lines 11-12 of the specification) to be sent from an originator (100) to a recipient (110). The method also provides that in response to input of the originator, generating a navigation that includes: a plurality of uniform resource locators that identify web pages to be viewed by the recipient (see page 6, lines 6-9 and 11-16 of the specification); and a color associated with each of the uniform resource locators according to a color code, wherein the color code indicates a preferred viewing order in which the web pages are to be viewed by the recipient (see page 7, lines 7-12 of the specification). The method also includes sending the email and the navigation to the recipient (see page 7, lines 2-3 of the specification).

INDEPENDENT CLAIM 9

With reference to page 6, line 6 to page 11, line 13 of the instant application and to Figs 1-4, and by way of non-limiting example, the invention provides for programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, wherein the programmable software comprises the acts of composing an email (see page 6, lines 11-12 of the specification) to be sent from an originator (100) to a recipient (110). The software also provides that in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient (see page 6, lines 6-9 and 11-16 of the specification). The software also provides for associating the navigation with the email (see page 6, line 16 to

page 7, line 2 of the specification) and sending the email and the navigation to the recipient (see page 7, lines 2-3 of the specification).

INDEPENDENT CLAIM 10

With reference to page 6, line 6 to page 11, line 13 of the instant application and to Figs 1-4, and by way of non-limiting example, the invention provides for programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, wherein the programmable software comprises the acts of receiving an email (see page 7, lines 2-3 of the specification) and receiving a web page navigation associated with the email (see page 7, lines 2-5 of the specification). The media also provides for passing the web page navigation to a web browser (see page 7, lines 2-5 of the specification) and displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed (see page 7, lines 5-6 of the specification). The preferred viewing order is included in the web page navigation (see page 16, lines 14-16 of the specification).

INDEPENDENT CLAIM 11

With reference to page 6, line 6 to page 11, line 13 of the instant application and to Figs 1-4, and by way of non-limiting example, the invention provides for programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, wherein the programmable software comprises the acts of composing an email (see page 6, lines 11-12 of the specification) to be sent from an originator (100) to a recipient (110). The software also provides that in response to input of the originator,

generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order (see page 6, lines 6-9 and 11-16 of the specification). Also included is sending the email and the web page navigation to the recipient (see page 7, lines 2-3 of the specification), passing the web page navigation to a web browser used by the recipient (see page 7, lines 2-5 of the specification), and displaying by the web browser an indication of the preferred viewing order (see page 7, lines 5-6 of the specification).

INDEPENDENT CLAIM 16

With reference to page 6, line 6 to page 11, line 13 of the instant application and to Figs 1-4, and by way of non-limiting example, the invention provides for programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, wherein the programmable software comprises the acts of composing an email (see page 6, lines 11-12 of the specification) to be sent from an originator to a recipient. The software also provides that in response to input of the originator, generating a navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient (see page 6, lines 6-9 and 11-16 of the specification) and a color associated with each of the uniform resource locators according to a color code, wherein the color code indicates a preferred viewing order in which the web pages are to be viewed by the recipient (see page 7, lines 7-12 of the specification). The software also provides for sending the email and the navigation to the recipient (see page 7, lines 2-3 of the specification).

(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claim 2 is improperly rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite.

Whether claims 1-3, 5, 7, 9-11, 13, 15 and 17-20 are improperly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER.

Whether claims 4, 6, 8, 12, 14 and 16 are improperly rejected under 35 U.S.C. § 103(a) as being Unpatenable over U.S. Patent No. 6,859,213 to CARTER in view of U.S. Patent No. 6,963,901 to BATES et al.

(VII) A. ARGUMENT RE. 112, 2nd PARAGRAPH, REJECTION

Claim 2 is improperly rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite, and this rejection should be withdrawn.

REJECTION OF DEPENDENT CLAIM 2 UNDER 35 U.S.C. § 112, 2ND PARAGRAPH, IS IN ERROR

The Examiner asserts that claim 2 is indefinite because “it is unclear what is the association and/or relationship between the web page and the email”, and clarifies in the Advisory Action that claim 2 is “very broad” and fails to explain how the navigation is associated with the email.

Claim 2 recites, among other things, receiving an email and receiving a web page navigation associated with the email. Appellant submits that one having ordinary skill in the art, having read the specification, would have no difficulty understanding what is claimed.

35 U.S.C. § 112, 2nd paragraph, does not require that each recited feature of a claim have an association or relationship to another recited feature. Nor does Section 112, 2nd paragraph require the claims to recite how something is associated. The specification provides this function (see, e.g., step 215 of Fig. 2 and paragraph [0021] of the instant published application 2002/0147779), i.e., associating the navigation with the email. Appellant also submits that the

Examiner has not cited any basis in patent law to support the Examiner's assertion of indefiniteness.

Because the above-noted claim has not been shown to be indefinite, Appellant submits that the above-noted rejection is improper, and should be reversed and withdrawn.

B. ARGUMENT RE. 102(e) REJECTION

Claims 1-3, 5, 7, 9-11, 13, 15 and 17-20 are improperly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER, and this rejection should be withdrawn.

REJECTION OF INDEPENDENT CLAIM 1 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 1 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient; associating the navigation with the email; and sending the email and the navigation to the recipient.

CARTER simply does not teach at least these features. Appellant acknowledges that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner counters that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Appellant respectfully disagrees.

The noted language merely discloses the following:

When the attach button 304 is activated, a dialogue box appears that allows the sender to navigate through a file system and select files to be attached to the e-mail message. Navigation is typically performed using a hierarchical list of file names. After one or more files are selected, the sender transmits the e-mail message and attached file(s) to a receiver. When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

When a sender wishes to attach HTML documents and other web-based information to an e-mail message, the sender uses the hierarchical list of file names to locate the desired document, or the sender specifies, such as through a text entry mechanism, a URL for each HTML document. Each web page is comprised of one or more separate files in a file system. These files can include, for example, an HTML document and text, graphics and sound files identified by "tags" within the HTML document. Web pages are typically linked to other web pages via embedded URL's. In many cases, dozens of web pages are linked to each other to form a related presentation of data. To send such linked pages using e-mail, each page is attached to an e-mail message for sending to a receiver.

An embodiment of the present invention provides for navigation and browsing of data resources, such as text, graphics and audio source data, when selecting attachments for an e-mail message. These data resources may also include source data containing data written in a markup language (e.g., HTML) that may be rendered by a browsing mechanism, and source data containing links such as embedded resource locators (e.g., URL's or other location references to data resources) that may be used by a browsing mechanism to navigate from one data resource to another. Data resources may contain source data in the form of one or more files, documents, streams and other sources of electronic information, or portions thereof.

By providing the ability to view the contents of prospective attachments before they are attached, a sender is able to confirm that the attachment contains the data expected. Also, via the browsing feature, a sender using an embodiment of the invention has access to advanced search engines on the web to further assist in the location of desired attachments. Advanced search features are not available in e-mail systems of the prior art.

In an embodiment of the invention, linked data resources can be traversed through standard browsing operations in order to locate a desired attachment. This is an advantage over navigation of a hierarchical list of file names, because a hierarchical file list does not provide information regarding possible embedded links to other files that may exist for web pages and other types of compound or linked documents. Further, web links via URL typically have little or no correspondence to particular file system hierarchies and often transcend single file systems, necessitating, in systems of the prior art, that the sender have knowledge of the particular URL's or the respective file names and directories for the web page or pages that are to be attached to an e-mail message.

FIG. 7 illustrates a method for selecting attachments in accordance with an embodiment of the invention. In step 700, during composition of an e-mail message, when a sender expresses a wish to select an attachment, a graphical user interface (GUI) with browser capability is presented to the sender. If the GUI interface is equipped with an attachment menu, the sender may select the type of the prospective attachment from the menu in step 701. Examples of types of attachment include attachment as a resource locator, such as a URL (universal resource locator), and attachment as source data of the chosen data resource, such as the set of data bits forming a rendered HTML document, or web page. An attachment may be retrieved as all source data of a chosen data resource or a subset thereof.

As is evident from a fair reading of the above-noted language, the Examiner's assertion is simply unsupported by the above-noted disclosure. In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order defined by the originator.

CARTER is also silent with regard to associating a navigation with the email and/or sending or receiving the email and the navigation. While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished

using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to view a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

Retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.

In the Advisory Action, the Examiner also explains that CARTER teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Appellant respectfully disagrees. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order, associating the navigation with the email, and sending the email and the navigation to the recipient. Attaching

URLs to an email is simply not the same as, e.g., associating a navigation which includes URLs with the email.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP § 2112, Appellant notes that MPEP § 2112 specifically states, in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least independent claim 1.

REJECTION OF INDEPENDENT CLAIM 2 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 2 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 2 recites, *inter alia*,

receiving a web page navigation associated with the email;
passing the web page navigation to a web browser; and
displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed;

wherein the preferred viewing order is included in the navigation.

CARTER simply does not teach at least these features. Appellant acknowledges that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner counters that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Appellant respectfully disagrees. As is evident from a fair reading of the above-noted language (reproduced above in the rejection of claim 1), the Examiner's assertion is simply unsupported by such disclosure. In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order.

CARTER is also silent with regard to associating a navigation with the email and/or receiving the email and the navigation. While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to view a viewing

order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

Retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including web pages in a preferred viewing order.

In the Advisory Action, the Examiner also explains that CARTER teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Appellant respectfully disagrees. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss receiving a web page navigation associated with the email that includes web pages and a preferred viewing order. Attaching URLs to an email is simply not the same as, e.g., associating a navigation which includes web pages to the email.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP § 2112, Appellant notes that MPEP § 2112 specifically states, in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least independent claim 2.

REJECTION OF INDEPENDENT CLAIM 3 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 3 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 3 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;
sending the email and the web page navigation to the recipient;
passing the web page navigation to a web browser used by the recipient; and
displaying by the web browser an indication of the preferred viewing order.

CARTER simply does not teach at least these features. Appellant acknowledges that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner counters that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Appellant respectfully disagrees. As is evident from a fair reading of the above-noted language (reproduced above in the rejection of claim 1), the Examiner's assertion is simply unsupported by such disclosure. In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order defined by the originator.

CARTER is also silent with regard to sending a navigation with the email and/or receiving the email and the navigation. While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to view a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

As the Examiner should know, retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.

In the Advisory Action, the Examiner also explains that CARTER teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Appellant respectfully disagrees. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order and sending the email and the navigation to the recipient. Attaching URLs to an email is simply not the same as, e.g., including a navigation in an email which includes URLs in a preferred viewing order.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP § 2112, Appellant notes that MPEP § 2112 specifically states, in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least independent claim 3.

REJECTION OF INDEPENDENT CLAIM 9 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 9 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;
associating the navigation with the email; and
sending the email and the navigation to the recipient.

CARTER simply does not teach at least these features. Appellant acknowledges that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner counters that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Appellant respectfully disagrees. As is evident from a fair reading of the above-noted language (reproduced above in the rejection of claim 1), the Examiner's assertion is simply unsupported by the above-noted disclosure. In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order defined by the originator.

CARTER is also silent with regard to associating a navigation with the email and/or sending or receiving the email and the navigation. While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to view a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position to the contrary. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box

that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

As the Examiner should know, retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.

In the Advisory Action, the Examiner also explains that CARTER teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Appellant respectfully disagrees. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order, associating the navigation with the email, and sending the email and the navigation to the recipient. Attaching URLs to an email is simply not the same as, e.g., associating a navigation which includes URLs with the email.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP § 2112, Appellant notes that MPEP § 2112 specifically states, in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least independent claim 9.

REJECTION OF INDEPENDENT CLAIM 10 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 10 recites, *inter alia*,

receiving a web page navigation associated with the email;
passing the web page navigation to a web browser; and
displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed;
wherein the preferred viewing order is included in the web page navigation.

CARTER simply does not teach at least these features. Appellant acknowledges that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner counters that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Appellant respectfully disagrees. As is evident from a fair reading of the above-noted language (reproduced above in the rejection of

claim 1), the Examiner's assertion is simply unsupported by such disclosure. In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order.

CARTER is also silent with regard to associating a navigation with the email and/or receiving the email and the navigation. While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to view a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position to the contrary. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

As the Examiner should know, retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including web pages in a preferred viewing order.

In the Advisory Action, the Examiner also explains that CARTER teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Appellant respectfully disagrees. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss receiving a web page navigation associated with the email that includes web pages and a preferred viewing order. Attaching URLs to an email is simply not the same as, e.g., associating a navigation which includes web pages to the email.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP § 2112, Appellant notes that MPEP § 2112 specifically states, in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least independent claim 10.

REJECTION OF INDEPENDENT CLAIM 11 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 11 recites, *inter alia*,

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;
sending the email and the web page navigation to the recipient;
passing the web page navigation to a web browser used by the recipient; and
displaying by the web browser an indication of the preferred viewing order.

CARTER simply does not teach at least these features. Appellant acknowledges that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner counters that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Appellant respectfully disagrees. As

is evident from a fair reading of the above-noted language (reproduced above in the rejection of claim 1), the Examiner's assertion is simply unsupported by such disclosure. In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order defined by the originator.

CARTER is also silent with regard to sending a navigation with the email and/or receiving the email and the navigation. While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to view a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position to the contrary. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

As the Examiner should know, retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.

In the Advisory Action, the Examiner also explains that CARTER teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Appellant respectfully disagrees. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order and sending the email and the navigation to the recipient. Attaching URLs to an email is simply not the same as, e.g., including a navigation in an email which includes URLs in a preferred viewing order.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP § 2112, Appellant notes that MPEP § 2112 specifically states, in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least independent claim 11.

REJECTION OF DEPENDENT CLAIM 5 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 5 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 5 depends from claim 3 and further recites:

wherein the indication of the preferred viewing order is provided by icons.

The Examiner identifies reference number 216 of CARTER as the recited icons.

Appellant disagrees. Col. 2, lines 54-56 of CARTER identifies reference number 216 as email messages and not icons which provide the indication of the preferred viewing order.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least dependent claim 5.

REJECTION OF DEPENDENT CLAIM 7 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 7 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 7 depends from claim 3 and further recites:

wherein the indication of the preferred viewing order is provided by forward and

backward browser controls.

The Examiner identifies reference numbers 403 and 404 of CARTER as the recited forward and backward browser controls. Appellant disagrees. Col. 8, lines 26-31 of CARTER identifies reference numbers 403 and 404 as previous page and next page buttons and not as forward and backward browser controls that provide an indication of the preferred viewing order.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least dependent claim 7.

REJECTION OF DEPENDENT CLAIM 13 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 13 depends from claim 11 and further recites:

wherein the indication of the preferred viewing order is provided by icons.

The Examiner identifies reference number 216 of CARTER as the recited icons. Appellant disagrees. Col. 2, lines 54-56 of CARTER identifies reference number 216 as email messages and not icons which provide the indication of the preferred viewing order.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least dependent claim 13.

REJECTION OF DEPENDENT CLAIM 15 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 15 depends from claim 11 and further recites:

wherein the indication of the preferred viewing order is provided by forward and backward browser controls.

The Examiner identifies reference numbers 403 and 404 of CARTER as the recited forward and backward browser controls. Appellant disagrees. Col. 8, lines 26-31 of CARTER identifies reference numbers 403 and 404 as previous page and next page buttons and not as forward and backward browser controls that provide an indication of the preferred viewing order.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least dependent claim 15.

REJECTION OF DEPENDENT CLAIM 17 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 17 depends from claim 1 and further recites:

wherein the preferred viewing order is specified by the originator and the email sent to the recipient contains the plurality of uniform resource locators and the preferred viewing order.

The Examiner explains on page 8 of the Final Office Action that CARTER teaches that messages can be sorted. This is beside the point. Claim 17 does not recite sorting messages. Claim 17 specifically recites that the preferred viewing order is specified by the originator and the email sent to the recipient contains the plurality of uniform resource locators and the preferred viewing order. This feature has not been shown to be disclosed in CARTER.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least dependent claim 17.

REJECTION OF DEPENDENT CLAIM 18 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 18 depends from claim 1 and further recites:

wherein an email program of the originator and a web browser of the originator together generate the web page navigation.

The Examiner explains on page 8 of the Final Office Action that CARTER teaches the features of claim 18 at col. 3, lines 17-41 and col. 4, line 45 to col. 5, line 26. Appellant disagrees. The Examiner has failed to explain how such language even remotely discloses that an email program of the originator and a web browser of the originator together generate the web page navigation.

Because the above-noted document fails to disclose, or even suggest, at least the above-

noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least dependent claim 18.

REJECTION OF DEPENDENT CLAIM 19 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 19 depends from claim 1 and further recites:

wherein the web page navigation is incorporated into the email sent to the recipient.

The Examiner explains on page 8 of the Final Office Action that CARTER teaches the features of claim 18 at col. 3, lines 17-41 and col. 4, line 45 to col. 5, line 26. Appellant disagrees. The Examiner has failed to explain how such language even remotely discloses that the web page navigation is incorporated into the email sent to the recipient.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least dependent claim 19.

REJECTION OF DEPENDENT CLAIM 20 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,859,213 to CARTER is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 20 depends from claim 1 and further recites:

receiving the email and the web page navigation with an email program of the recipient;

passing the web page navigation to a web browser of the recipient; and displaying an indication of the preferred order with the web browser of the recipient.

The Examiner explains on page 9 of the Final Office Action that CARTER teaches that messages can be sorted. This is beside the point. Claim 20 does not recite sorting messages. Claim 20 instead specifically recites receiving the email and the web page navigation with an email program of the recipient, passing the web page navigation to a web browser of the recipient, and displaying an indication of the preferred order with the web browser of the recipient. This feature has not been shown to be disclosed in CARTER.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper reading of CARTER renders anticipated the combination of features recited in at least dependent claim 20.

C. ARGUMENT RE. 103(a) REJECTION

Claims 4, 6, 8, 12, 14 and 16 are improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over CARTER in view of U.S. Patent No. 6,963,901 to BATES et al., and this rejection should be withdrawn.

REJECTION OF INDEPENDENT CLAIM 8 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 8 under 35 U.S.C. § 103(a) as being anticipated by CARTER in view of BATES is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 8 recites:

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

associating the navigation with the email; and sending the email and the navigation to the recipient.

CARTER simply does not teach at least these features. Appellant acknowledges that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner counters that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Appellant respectfully disagrees. As is evident from a fair reading of the noted language (reproduced above in the rejection of claim 1), the Examiner's assertion is simply unsupported by such disclosure. In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order defined by the originator.

CARTER is also silent with regard to generating a navigation for sending with the email and/or sending the email and the navigation. While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to view

a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position to the contrary. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

As the Examiner should know, retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.

In the Advisory Action, the Examiner also explains that CARTER teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Appellant respectfully disagrees. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order and sending the email and the navigation to the recipient. Attaching URLs to an email is simply not the same as, e.g., generating a navigation which includes URLs with the email.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP § 2112, Appellant notes that MPEP § 2112 specifically states, in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. BATES has not been shown to disclose or suggest at least the above-noted features.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of CARTER and BATES renders unpatentable the combination of features recited in at least independent claim 8.

REJECTION OF DEPENDENT CLAIM 4 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 4 under 35 U.S.C. § 103(a) as being anticipated by CARTER in view of BATES is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 4 depends from claim 3 and further recites:

wherein the indication of the preferred viewing order is provided by link colors.

The Examiner identifies reference number 244 of BATES as the recited font

characteristics that provide an indication of the preferred viewing order. Appellant disagrees. The cited language of BATES is entirely silent with regard to link colors that provide an indication of the preferred viewing order, and the Examiner has not demonstrated otherwise.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of CARTER and BATES renders unpatentable the combination of features recited in at least dependent claim 4.

REJECTION OF DEPENDENT CLAIM 6 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 6 under 35 U.S.C. § 103(a) as being anticipated by CARTER in view of BATES is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 6 depends from claim 3 and further recites:

wherein the indication of the preferred viewing order is provided by font characteristics.

The Examiner identifies reference number 244 of BATES as the recited font characteristics that provide an indication of the preferred viewing order. Appellant disagrees. The cited language of BATES is entirely silent with regard to font characteristics that provide an indication of the preferred viewing order, and the Examiner has not demonstrated otherwise.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of CARTER and BATES renders unpatentable the combination of features recited in at least dependent claim 6.

REJECTION OF DEPENDENT CLAIM 12 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 12 under 35 U.S.C. § 103(a) as being anticipated by CARTER in view of BATES is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 12 depends from claim 11 and further recites:

wherein the indication of the preferred viewing order is provided by link colors.

The Examiner identifies reference number 244 of BATES as the recited font characteristics that provide an indication of the preferred viewing order. Appellant disagrees. The cited language of BATES is entirely silent with regard to link colors that provide an indication of the preferred viewing order, and the Examiner has not demonstrated otherwise.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of CARTER and BATES renders unpatentable the combination of features recited in at least dependent claim 12.

REJECTION OF DEPENDENT CLAIM 14 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 14 under 35 U.S.C. § 103(a) as being anticipated by CARTER in view of BATES is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 14 depends from claim 11 and further recites:

wherein the indication of the preferred viewing order is provided by font characteristics.

The Examiner identifies reference number 244 of BATES as the recited font

characteristics that provide an indication of the preferred viewing order. Appellant disagrees. The cited language of BATES is entirely silent with regard to font characteristics that provide an indication of the preferred viewing order, and the Examiner has not demonstrated otherwise.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of CARTER and BATES renders unpatentable the combination of features recited in at least dependent claim 14.

REJECTION OF INDEPENDENT CLAIM 16 UNDER 35 U.S.C. § 102 IS IN ERROR

The rejection of claim 16 under 35 U.S.C. § 103(a) as being anticipated by CARTER in view of BATES is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 16 recites:

in response to input of the originator, generating a navigation that includes:
a plurality of uniform resource locators that identify web pages to be viewed by the recipient; and
a color associated with each of the uniform resource locators according to a color code, wherein the color code indicates a preferred viewing order in which the web pages are to be viewed by the recipient; and
sending the email and the navigation to the recipient.

CARTER simply does not teach at least these features. Appellant acknowledges that CARTER discloses the sending of an email with attached HTML documents (see col. 3, lines 28-41). However, CARTER does not disclose, or even suggest, that the sent email includes a viewing order of the HTML documents, much less, a preferred viewing order.

The Examiner counters that CARTER in fact teaches the recited preferred viewing order at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26. Appellant respectfully disagrees. As is evident from a fair reading of the noted language (reproduced above in the rejection of claim 1), the Examiner's assertion is simply unsupported by such disclosure. In fact, it is clear from a fair reading of the above-noted language that there is no disclosure whatsoever with regard to any viewing order, much less, a preferred viewing order. Nor does CARTER disclose or suggest the sending and/or receiving of emails which include a web page navigation having any viewing order, much less, a preferred viewing order defined by the originator.

CARTER is also silent with regard to generating a navigation for sending with the email and/or sending the email and the navigation. While it is true that CARTER discloses that the sender can attach files to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The GUI of CARTER, which the Examiner identifies as being able to allow the receiver to view a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position to the contrary. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box

that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system.

As the Examiner should know, retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.

In the Advisory Action, the Examiner also explains that CARTER teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Appellant respectfully disagrees. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order and sending the email and the navigation to the recipient. Attaching URLs to an email is simply not the same as, e.g., generating a navigation which includes URLs with the email.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP § 2112, Appellant notes that MPEP § 2112 specifically states, in part:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

BATES has not been shown to disclose or suggest at least the above-noted features.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellant submits that no proper combination of CARTER and BATES renders unpatentable the combination of features recited in at least independent claim 16.

CONCLUSION

Each of claims 1-20 are patentable under 35 U.S.C. §§ 112, 102(b) and 103(a).

Accordingly, Appellant respectfully requests that the Board reverse the decision of the Examiner to reject claims 1-20 under 35 U.S.C. §§ 112, 102(b) and 103(a), and remand the application to the Examiner for withdrawal of the above-noted rejections. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0457.

Respectfully submitted,

C. L. BATES, *et al.*



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Attachments:
 Claims Appendix
 Evidence Appendix
 Related Proceedings Appendix

VIII. CLAIMS APPENDIX

1. A method for providing email that enables a recipient of the email to navigate readily through a set of web pages associated with the email, comprising the acts of:

composing an email to be sent from an originator to a recipient;

In response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

associating the navigation with the email; and

sending the email and the navigation to the recipient.

2. A method for guiding a recipient of an email readily through a set of web pages associated with the email, comprising the acts of:

receiving an email;

receiving a web page navigation associated with the email;

passing the web page navigation to a web browser; and

displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed;

wherein the preferred viewing order is included in the navigation.

3. A method for providing email that guides a recipient readily through a set of associated web pages, comprising the acts of:

composing an email to be sent from an originator to a recipient;

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;

sending the email and the web page navigation to the recipient;

passing the web page navigation to a web browser used by the recipient; and

displaying by the web browser an indication of the preferred viewing order.

4. The method of claim 3, wherein the indication of the preferred viewing order is provided by link colors.

5. The method of claim 3, wherein the indication of the preferred viewing order is provided by icons.

6. The method of claim 3, wherein the indication of the preferred viewing order is provided by font characteristics.

7. The method of claim 3, wherein the indication of the preferred viewing order is provided by forward and backward browser controls.

8. A method for providing email that guides a recipient readily through a set of associated web pages, comprising the acts of:

composing an email to be sent from an originator to a recipient;

in response to input of the originator, generating a navigation that includes:

a plurality of uniform resource locators that identify web pages to be viewed by the recipient; and

a color associated with each of the uniform resource locators according to a color code, wherein the color code indicates a preferred viewing order in which the web pages are to be viewed by the recipient; and

sending the email and the navigation to the recipient.

9. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, the programmable software comprising the acts of:

composing an email to be sent from an originator to a recipient;

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order in which web pages identified by the plurality of uniform resource locators are to be viewed by the recipient;

associating the navigation with the email; and

sending the email and the navigation to the recipient.

10. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, the programmable software comprising the acts of:

receiving an email;

receiving a web page navigation associated with the email;

passing the web page navigation to a web browser; and

displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed;

wherein the preferred viewing order is included in the web page navigation.

11. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, the programmable software comprising the acts of:

composing an email to be sent from an originator to a recipient;

in response to input of the originator, generating a web page navigation that includes a plurality of uniform resource locators that identify web pages to be viewed by the recipient in a preferred viewing order;

sending the email and the web page navigation to the recipient;

passing the web page navigation to a web browser used by the recipient; and

displaying by the web browser an indication of the preferred viewing order.

12. The method of claim 11, wherein the indication of the preferred viewing order is provided by link colors.

13. The method of claim 11, wherein the indication of the preferred viewing order is provided by icons.

14. The method of claim 11, wherein the indication of the preferred viewing order is provided by font characteristics.

15. The method of claim 11, wherein the indication of the preferred viewing order is provided by forward and backward browser controls.

16. Programmable media containing programmable software for providing email that guides a recipient readily through a set of associated web pages, the programmable software comprising the acts of:

composing an email to be sent from an originator to a recipient;

in response to input of the originator, generating a navigation that includes:

a plurality of uniform resource locators that identify web pages to be viewed by the recipient; and

a color associated with each of the uniform resource locators according to a color code, wherein the color code indicates a preferred viewing order in which the web pages are to be

viewed by the recipient; and

sending the email and the navigation to the recipient.

17. The method of claim 1, wherein the preferred viewing order is specified by the originator and the email sent to the recipient contains the plurality of uniform resource locators and the preferred viewing order.

18. The method of claim 1, wherein an email program of the originator and a web browser of the originator together generate the web page navigation.

19. The method of claim 1, wherein the web page navigation is incorporated into the email sent to the recipient.

20. The method of claim 1, further comprising:

receiving the email and the web page navigation with an email program of the recipient;

passing the web page navigation to a web browser of the recipient; and

displaying an indication of the preferred order with the web browser of the recipient.

IX. EVIDENCE APPENDIX

This section lists evidence submitted pursuant to 37 C.F.R. §§1.130, 1.131, or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this appeal, and provides for each piece of evidence a brief statement setting forth where in the record that evidence was entered by the Examiner. Copies of each piece of evidence are provided as required by 37 C.F.R. §41.37(c)(ix).

| NO. | EVIDENCE | BRIEF STATEMENT SETTING FORTH WHERE IN THE RECORD THE EVIDENCE WAS ENTERED BY THE EXAMINER |
|-----|----------|--|
| 1 | N/A | N/A |

X. RELATED PROCEEDINGS APPENDIX

Pursuant to 37 C.F.R. §41.37(c)(x), copies of the following decisions rendered by a court of the Board in any proceeding identified above under 37 C.F.R. §41.37(c)(1)(ii) are enclosed herewith.

| NO. | TYPE OF PROCEEDING | REFERENCE NO. | DATE |
|-----|--------------------|---------------|------|
| 1 | N/A | N/A | N/A |